

REMARKS/ARGUMENTS

This response responds to the Office Action dated December 7, 2010 in which the Examiner rejected claims 1-2, 4-6 and 8-11 under 35 U.S.C. § 103.

Claims 1-2 were rejected under 35 U.S.C. § 103 as being unpatentable over *Kuroda* (U.S. Patent No. 6,311,011) in view of *Ellis, et al.* (U.S. Publication No. 2003/0149988).

Applicants respectfully traverse the Examiner's rejection of the claims under 35 U.S.C. § 103. The claims have been reviewed in light of the Office Action, and for reasons which will be set forth above, Applicants respectfully request the Examiner withdraws the rejection to the claims and allows the claims to issue.

Kuroda appears to disclose a storage device 105 stores content signals according to a viewer's direction. The storage device 105 may comprise a plurality of storage device with a removable medium. The storage device 105 may be built-in the video recorder/player or connected with the video recorder/player as a peripheral device (column 4, lines 38-44). In reference with Figure 3, a description will be made about a recording action of the video recorder/player (column 5, lines 9-11). If the remaining capacity is insufficient at Step 107, Step 111 is executed. A dialog of Figure 6 warns that the storage device selected at Step 106 does not have sufficient capacity for recording the contents and allows the viewer a choice to select another storage device or to record the storage device at Step 106 (Step 111). If another storage device is selected, then Step 112 follows Step 111 or else Step 108 follows Step 111 (column 5, lines 60-67).

Thus, *Kuroda* only discloses storage device 105 can be built-in or a peripheral device and determining if there is sufficient capacity to record, and if not, select another storage device. Nothing in *Kuroda* shows, teaches or suggests (a) a connection means connecting with an

external device, (b) an external device which is external to the recording system (*i.e.* external to the receiving means, accepting means, local storage means, connection means, determining means and issuing means), (c) the external device separately receives a program from a distribution center independently of the recording system, (d) a connection means connecting via internet to the external device and (e) the external device receiving a program via unidirectional communication as claimed in claim 1. Rather, column 4, lines 38-44 of *Kuroda* only discloses a storage device 105 which is built-in or a peripheral device while column 5, lines 60-65 merely discloses determining if the storage device has sufficient capacity to store the program.

Applicants respectfully point out that even if the storage device is peripheral to the recorder/player, it is not external to the recording system but is still part of the recording system.

Additionally, *Kuroda* appears to disclose in Figure 22 an electronic program guide (EPG) screen when the viewer is selecting one of the storage devices managed by the EPG displaying device (column 11, lines 27-29). In Figure 7, video recorder/player records all of content signals in the storage device 105 via the temporary storage device 103. The video recorder/player copies content signals from the temporary storage device 103 into the storage device 105 in order of signal arrival at the tuner 102 (Step 201). When the content signals are copied into the storage device 105, the video recorder/player deletes the signals from the temporary storage device 103 (column 6, lines 5-23).

Thus, Figure 22 of *Kuroda* only discloses a screen used to select one of the storage devices while Figure 7 merely discloses copying signals from the temporary storage device into the storage device 105. Thus, nothing in *Kuroda* shows, teaches or suggests issuing a recording substitution request to an external device when a failure is determined in a recording system as claimed in claim 1. Rather, *Kuroda* only discloses showing a screen to a user to select another

storage device (Figure 22) or to copy a signal from a temporary storage device of the recorder/player to another storage device of the recorder/player (*i.e.* the storage device are not external to the recorder/player).

Furthermore, nothing in *Kuroda* shows, teaches or suggests (a) issuing a recording substitution request via the internet by a connection means or (b) having an external device record a program, received from a distribution center, upon receipt of a request based upon a failure in the recording system as claimed in claim 1. Rather, *Kuroda* only discloses in Figure 22 showing a screen to a user to select another storage device if capacity is insufficient. Applicants respectfully point out that insufficient capacity does not mean that there is a failure since as shown in Figure 3, Step 108, the recording can still proceed. Furthermore, *Kuroda* never discloses that another storage device is (1) external to the recorder/player, (2) connected by a connection means via the internet, (3) separately receives the program from the distribution center independently of the recording system and (4) separately receives the program by unidirectional communication as claimed in claim 1.

Ellis, et al. appears to disclose communication paths may be any communication path suitable for distributing program guide data [0065]. Remote media server 24 of Figures 2a-2c records programs, program guide data or any suitable combination thereof and supplies either or both to user television equipment 22 in response to requests generated by the program guide [0075]. Remote media server 24 records programs and associated program guide data on storage 15 in response to requests generated by the program guide [0084]. The interactive television program guide may run totally on user television equipment 22 using the arrangements of Figure 2a and 2c or may run partially on user television equipment 22 and partially on interactive

program guide television equipment 17 using a suitable client-server or distributed processing arrangement such as shown in Figures 2a and 2d [0063].

Thus, *Ellis, et al.* only discloses a communication path within the interactive program guide television equipment 17 between the program guide distribution facility 16 and user television equipment 22. Thus, nothing in *Ellis, et al.* shows, teaches or suggests (a) a connection means for connecting with an external device, (b) the external device is external to the recording system (*i.e.* external to a receiving means, accepting means, local storage means, connecting means, determining means and issuing means), (c) the external device separately receives a program from a distribution center independently of the recording system and (d) the external device receives the program via unidirectional communication as claimed in claim 1. Rather, *Ellis, et al.* only discloses in paragraph [0065] communication within the interactive program guide television equipment 17 between the program guide distribution facility 16 and the user television equipment 22, in paragraph [0075] a remote media server 24 of the equipment 17 recording and supplying program and program guide data to the user equipment 22 based on a request generated by the program guide, and in paragraph [0084] recording programs and program guide data in remote server 24 of equipment 17 in response to a request generated by the program guide. Applicants respectfully point out to the Examiner that the devices of *Ellis, et al.* are all internal to equipment 17 and thus *Ellis, et al.* do not disclose the connection means of a recording system as claimed in claim 1.

Additionally, *Ellis, et al.* appears to disclose a remote media server 24 records programs and program guide data on storage 15 in response to record requests generated by the program guide implemented on the interactive program guide television equipment 17 [0084]. The record requests generated by program guides implemented on interactive program guide television

equipment 17 may be queued in request queue 110 for consolidation [0085]. The communication paths 20 may be any communication paths suitable for distributing program guide data [0065]. If the program guide is implemented on user television equipment 22 of interactive program guide television equipment 17 as shown in Figure 2c, internet service system 61 may provide program guide data to user television equipment 22 via the internet or via program guide distribution equipment 21. If the program guide implemented on interactive program guide television equipment 17 is a client-server guide as shown in Figure 2d, program guide server 25 may obtain program guide data from internet service system 61 [0070]. An online program guide can be implemented using a personal computer 231 as shown in Fig. 2e [0072]. Programs and program guide data may be recorded and played back on demand by remote media server 24 in response to record and playback requests generated by a program guide server application or web application [0074]. Figure 2c and 2d show internet based interactive television program guide systems [0069].

Thus, *Ellis, et al.* only discloses a remote server 24 of equipment 17 records a program in response to a request generated by a program guide [0084]. Nothing in *Ellis, et al.* shows, teaches or suggests issuing a recording substitution request in response to a determination means determining a failure in the recording system as claimed in claim 1. Rather, *Ellis, et al.* only discloses that the request to record a program is generated by the program guide.

Furthermore, *Ellis, et al.* only discloses the program can be recorded and played back by server 24 of equipment 17 in response to a record and play back request. Nothing in *Ellis, et al.* shows, teaches or suggests an external device records a program received from a distribution center upon receipt of a recording substitution request which is sent based upon a failure in the recording system as claimed in claim 1. Rather, *Ellis, et al.* only discloses in paragraph [0074]

recording and play back in response to a recording and play back request (*i.e.* requests are internal to equipment 17).

Applicants respectfully submit that the Examiner appears to be selecting bits and pieces of each reference without regard to the teachings of those references. Thus, the Examiner appears to take laundry list of items A, B and C and associating them with items D, E and F regardless of what each reference teaches about the items. Applicants respectfully submit that it is impermissible to pick and choose from any one reference, only so much of it as will support a given position, to the exclusion of the other parts necessary to the full appreciation of what such reference suggests to one of ordinary skill in the art. As pointed out in *in re Suitco Surface, Inc.* (94 U.S.P.Q. 2nd 1640, Fed. Circuit 2010) "the broadest construction rubric coupled with the term "comprising" does not give the PTO an unfettered license to interpret claims to embrace anything remotely related to the claimed invention. Rather, a claim should always be read in light of the Specification and teachings of the underlying patent".

A combination of *Kuroda* and *Ellis, et al.* would merely suggest that if capacity of a recorder is not sufficient, to ask the user to select either another storage device or to record on a storage device with insufficient capacity as taught by *Kuroda* and to record a program in response to a record/play back request when equipment 17 as taught by *Ellis, et al.* Thus, nothing in the combination of the references shows, teaches or suggests a recording system including (a) a connection means for connecting with an external device which is external to the recording system, the external device separately receiving a program via unidirectional communication from a distribution center independently of the recording system and (b) a means for issuing a recording substitution request to the external device in response to a determination of a failure in the recording system, the external device records the program received from the

distribution center upon receipt of the recording substitution request as claimed in claim 1.

Therefore, Applicants respectfully requests the Examiner withdraws the rejection to claim 1 under 35 U.S.C. § 103.

Claim 2 depends from claim 1 and recites additional features. Applicants respectfully submit that claim 2 would not have been obvious within the meaning of 35 U.S.C. § 103 over *Kuroda* and *Ellis, et al.* at least for the reasons as set forth above. Therefore, Applicants respectfully request the Examiner withdraws the rejection to claim 2 under 35 U.S.C. § 103.

Claims 4-6 and 9 were rejected under 35 U.S.C. § 103 as being unpatentable over *Kuroda* in view of *Ellis, et al.* and *Zigmond, et al.* (U.S. Patent No. 6,698,020).

Applicants respectfully traverse the Examiner's rejection of the claims under 35 U.S.C. § 103. The claims have been reviewed in light of the Office Action, and for reasons which will be set forth below, Applicants respectfully request the Examiner withdraws the rejection to the claims and allows the claims to issue.

As discussed above, *Kuroda*. at column 4, lines 38-44 only discloses a built-in or peripheral storage device 105 which stores content signals while column 5, lines 60-65 merely discloses if the storage device has insufficient capacity, asking a user to select a different storage device or to let the user continue to store the information on the current storage device. Thus, nothing in *Kuroda* shows, teaches or suggests a connection means connecting with external devices as claimed in claims 4 and 9. Rather, *Kuroda* only discloses that only storage device 105 may be a peripheral device but device 105 is still associated with the video recorder/player and thus is not external devices. Furthermore, nothing in *Kuroda* shows, teaches or suggests external devices which are external to a recording substitution system (*i.e.* external to a connection means, receiving means, first and second storage means, recording substitution means and user

information management means) as claimed in claim 4. Rather, *Kuroda* only discloses a storage device 105 associated with the video recorder/player storing content signals (column 4, lines 38-44) and displaying a warning to a user if insufficient capacity occurs on a recording device in order to select or not another device (column 5, lines 60-65).

Kuroda discloses temporary storage device 103 and storage device 105. Nothing in *Kuroda* shows, teaches or suggests a first storage means/portion recording program content and a second storage means/portion storing program content with advertising information (a) selected for one of the external devices as claimed in claims 4 or (b) received from the internet independent of the program distribution station as claimed in claim 9. Rather, the storage devices 103, 105 of *Kuroda* both store content signals.

Furthermore, Figure 22 of *Kuroda* only shows an electronic program guide screen when a user selects one of the storage devices (column 11, lines 27-29), Figure 7 only discloses recording the content signals in the storage device 105 by copying information from the temporary storage device 103 (column 6, lines 6-23) while column 5, lines 60-65 warns a user when insufficient capacity remains in the selected storage device. Thus, nothing in *Kuroda* shows, teaches or suggests a recording substitution means/portion (a) responding to a recording request from an external device, (b) obtaining advertising information from another external device, (c) storing (both) program content and advertising information in a second recording means where the advertising information is (1) stored as an insert into the recorded program content, (2) stored as a substitute for the original commercial information as claimed in claims 4 and 9. Rather, *Kuroda* only discloses in Figure 22 an electronic program guide screen, in Figure 7 copying information from the temporary storage 103 into the storage device 105 and in column 5, lines 60-65 warning a user of insufficient capacity in the current storage device.

Ellis, et al. appears to disclose a program guide data transmitted by main facility 12 to interactive program guide television equipment 17 may include television programming data including any type of show or advertisement and may include commercials [0060]. Distribution equipment 21 of Figs. 2a-2d provides program guide data to user television equipment 22 over communication paths 20 [0064]. Figure 2b shows an arrangement for interactive program guide television equipment 17 in a client-server based or distributed interactive program guide system [0066]. Figures 2c and 2d show internet based interactive television program guide systems [0069]. The internet service system 61 may provide program guide data to user television equipment 22 via the internet [0070].

Thus, *Ellis, et al.* merely discloses distributing programs and program guide data via various methods including the internet. Nothing in *Ellis, et al.* shows, teaches or suggests a recording substitution system including a connection means/portion for connecting with external devices as claimed in claims 4 and 9 and that the external devices are external to the recording substitution system (*i.e.* external to the connection means, receiving means, first and second storage means, recording substitution means and user information management means) as claimed in claim 4. Rather, *Ellis, et al.* only discloses transmitting program guide information by a main facility 12 to program guide television equipment 17.

Additionally, as discussed above, *Ellis, et al.* discloses in paragraph [0065] a communication path 20, in paragraph [0070] providing the program guide to the user's via the internet, in paragraph [0072] providing an online program guide to a PC via the internet, in paragraph [0074] program playback on demand in response to a record/playback request generated by the program guide, in paragraph [0084] record a program in response to a request generated by the program guide, in paragraph [0085] recording a request generated by the

program guide put in queues, in paragraph [0086] determine if a certain number of users have requested to record a program, in paragraph [0088] processing circuitry 11 of remote media server 24 will direct tuners to different stations to record programs, and in paragraph [0105] a set-top box may communicate directly with program guide server 25, remote media server 24 or internet service system 61 over communication path 20.

Thus, *Ellis, et al.* only discloses recording a program in response to a request generated by the program guide. Nothing in *Ellis, et al.* shows, teaches or suggests a recording substitution means (a) obtaining advertising information from another external device, and (b) storing recorded program content and advertisement information in a second storage means where the advertisement information is (1) stored as an insert into the recorded program content or (2) stored as a substitute for the original commercial information as claimed in claims 4 and 9. Rather, *Ellis, et al.* only discloses recording a program in response to a request generated by a program guide.

Also, *Ellis, et al.* merely discloses in Figure 7 the user television equipment 22 [0098]. Optional digital storage device 31 is used to run the interactive television program guide [0099]. Secondary storage device 32 may be any suitable type of analog or digital program storage device or player [0100]. Digital storage device 31 can be contained in set-top box 20 or can be an external device connected to the set-top box 20. The data stream is stored in the digital storage device 31 [0102]. Local media server 29 may have processing circuitry 33, memory 35 and storage 37 [0109].

Thus, *Ellis, et al.* merely discloses different storage devices. However, nothing in *Ellis, et al.* shows, teaches or suggests (a) a first storage means/portion recording program content as claimed in claims 4 and 9, (b) a second storage means for storing the program content with

advertising information selected for at least one of the external devices as claimed in claim 4, (c) a recording substitution means obtaining advertising information from another external device as claimed in claim 4 or (d) a second storage portion configured to store the program content with advertising content which is received independent of the distribution station distributing the program as claimed in claim 9. Rather, the various storage devices of *Ellis, et al.* are only to store the program guide or a data stream.

Zigmond, et al. appears to disclose methods and systems for selecting and inserting advertisements into a video programming feed at the household level (column 1, lines 10-12, emphasis added). Viewer response information is collected in a statistics collection location 61 which may be located at the home entertainment system or at a remote site (column 9, lines 39-55).

Thus, *Zigmond, et al.* only discloses collecting statistics. Nothing in *Zigmond, et al.* shows, teaches or suggests a recording substitution system including a connection means/portion for connecting with external devices as claimed in claims 4 and 9. Furthermore, nothing in *Zigmond, et al.* shows, teaches or suggests the external devices are external to the recording substitution system (*i.e.* external to the connection means, receiving means, first and second storage means, recording substitution means and user information management means) as claimed in claim 4. Rather, *Zigmond, et al.* only discloses collecting viewer response information.

Additionally, *Zigmond, et al.* merely discloses an ad selection criteria 83 used to select advertisements (column 13, lines 38-52), storing ad selection criteria 83 in an ad insertion device 80 (column 11, lines 31-65) and an advertisement repository 86 (column 15, lines 25-30).

Thus, *Zigmond, et al.* merely discloses storing advertisements. Nothing in *Zigmond, et al.* shows, teaches or suggests a second storage means storing program content with advertising information selected for at least one of the external devices as claimed in claim 4. Rather, *Zigmond, et al.* stores the ads independent of the program content. Furthermore, nothing in *Zigmond, et al.* shows, teaches or suggests a second storage portion configured to store the program content with advertising content which is received independent of the distribution station and received via the internet as claimed in claim 9. Rather, *Zigmond, et al.* only discloses storing the advertisements independent of the program content.

Furthermore, *Zigmond, et al.* discloses content providers are independent television stations, video tape or any other medium carrying recorded video programming. The content provider 50 broadcasts advertisements 54 that are included in the video programming feed 52 (column 7, lines 10-20). Appropriate advertisement is selected based in part on whether the video programming feed is watched as a broadcast or being replayed from recorded media. Advertisers can update ads when advertisements have been recorded. Advertisements originally recorded a video tape or other recorded medium can be replaced with effectively targeted ads based on any other desired criteria (column 14, lines 1-12). An advertisement repository is provided (column 15, lines 24-34). An ad insertion device 80 including means for detecting a triggering event indicating an appropriate time to display the selected advertisement (column 15, lines 35-37).

Thus, *Zigmond, et al.* merely discloses inserting an ad into a live feed or stored feed. Nothing in *Zigmond, et al.* shows, teaches or suggests recording program content in a first storage means/portion and storing both the program content and advertising information in a storage means/portion as claimed in claims 4 and 9. Furthermore, nothing in *Zigmond, et al.*

shows, teaches or suggests a recording substitution means obtaining the advertisement information from an external device as claimed in claim 4. Also, nothing in *Zigmond, et al.* shows, teaches or suggests a recording substitution means/portion storing the recorded program content and advertising information in a second recording means where the advertising information is (1) inserted into the recorded program content or (2) stored as a substitute for the original commercial information as claimed in claims 4 and 9. Applicants respectfully point out that the advertisement information in *Zigmond, et al.* is inserted into the feed. Nothing in *Zigmond, et al.* shows, teaches or suggests storing the inserted or substituted advertisement with the recorded program content in a storage means. The ads in *Zigmond, et al.* are stored and added separately to the feed.

A combination of *Kuroda, Ellis, et al.* and *Zigmond, et al.* would merely suggest to store information in a storage device 105 and to warn a user if there is insufficient capacity as taught by *Kuroda*, to record a program in response to a request generated by a program guide as taught by *Ellis, et al.* while separately storing ads which are output during the feed of the program as taught by *Zigmond, et al.* Thus, nothing in the combination of the references shows, teaches or suggests (a) a connection means/portion connecting with external devices, (b) a first storage means/portion storing a program content, (c) a second storage means/portion storing the program content with advertising information and (d) a recording substitution means/portion storing the recorded program content and advertising information in the second storage means where the advertising information is (1) stored as an insert into the recorded program or (2) stored as a substitute for the original commercial information in the recorded program content as claimed in claims 4 and 9. Therefore, Applicants respectfully request the Examiner withdraws the rejection to claims 4 and 9 under 35 U.S.C. § 103.

Claims 5-6 depend from claim 4 and recite additional features. Applicants respectfully submit that claims 5-6 would not have been obvious within the meaning of 35 U.S.C. § 103 over *Kuroda, Ellis, et al.* and *Zigmond, et al.* at least for the reasons as set forth above. Therefore, Applicants respectfully request the Examiner withdraws the rejection to claims 5-6 under 35 U.S.C. § 103.

Claim 8 was rejected under 35 U.S.C. § 103 as being unpatentable over *Kuroda* in view of *Lawler, et al.* (U.S. Patent No. 5,805,763).

Applicants respectfully traverse the Examiner's rejection of the claim under 35 U.S.C. § 103. The claim has been reviewed in light of the Office Action and for reasons which will be set forth below, Applicant's respectfully request the Examiner withdraws the rejection to the claim and allows the claim to issue.

Kuroda appears to disclose a storage device 105 stores content signals according to a viewer's direction. The storage device 105 may comprise a plurality of storage device with a removable medium. The storage device 105 may be built-in the video recorder/player or connected with the video recorder/player as a peripheral device (column 4, lines 38-44). In reference with Figure 3, a description will be made about a recording action of the video recorder/player (column 5, lines 9-11). If the remaining capacity is insufficient at Step 107, Step 111 is executed. A dialog of Figure 6 warns that the storage device selected at Step 106 does not have sufficient capacity for recording the contents and allows the viewer a choice to select another storage device or to record the storage device at Step 106 (Step 111). If another storage device is selected, then Step 112 follows Step 111 or else Step 108 follows Step 111 (column 5, lines 60-67).

Thus, *Kuroda* only discloses storage device can be built-in or a peripheral device and determining if there is sufficient capacity to record, and if not, select another storage device. Nothing in *Kuroda* shows, teaches or suggests (a) a connection portion connecting with an external storage device, (b) an external storage device which is external to the recording system (*i.e.* external to the receiving portion, accepting portion, local storage portion, connection portion, determining portion and issue portion), (c) the external storage device separately receives a program from a distribution center independently of the recording system, (d) a connection portion connecting via internet to the external storage device and (e) the external storage device receiving a program via unidirectional communication as claimed in claim 8. Rather, column 4, lines 38-44 of *Kuroda* only discloses a storage device 105 which is built-in or a peripheral device while column 5, lines 60-65 merely discloses determining if the storage device has sufficient capacity to store the program. Applicants respectfully point out that even if the storage device is peripheral to the recorder/player, it is not external to the recording system but is still part of the recording system.

Additionally, *Kuroda* appears to disclose in Figure 22 an electronic program guide (EPG) screen when the viewer is selecting one of the storage devices managed by the EPG displaying device (column 11, lines 27-29). In Figure 7, video recorder/player records all of content signals in the storage device 105 via the temporary storage device 103. The video recorder/player copies content signals from the temporary storage device 103 into the storage device 105 in order of signal arrival at the tuner 102 (Step 201). When the content signals are copied into the storage device 105, the video recorder/player deletes the signals from the temporary storage device 103 (column 6, lines 5-23).

Thus, Figure 22 of *Kuroda* only discloses a screen used to select one of the storage devices while Figure 7 merely discloses copying signals from the temporary storage device into the storage device 105. Thus, nothing in *Kuroda* shows, teaches or suggests issuing a recording substitution request to an external storage device when a failure is determined in a recording system as claimed in claim 8. Rather, *Kuroda* only discloses showing a screen to a user to select another storage device (Figure 22) or to copy a signal from a temporary storage device of the recorder/player to another storage device of the recorder/player (*i.e.* the storage device are not external to the recorder/player).

Furthermore, nothing in *Kuroda* shows, teaches or suggests (a) automatically issuing a recording substitution request via the internet through a connection portion or (b) having an external storage device record a program, received from a distribution center, upon receipt of a request based upon a failure in the recording system as claimed in claim 8. Rather, *Kuroda* only discloses in Figure 22 showing a screen to a user to select another storage device if capacity is insufficient. Applicants respectfully point out that insufficient capacity does not mean that there is a failure since as shown in Figure 3, Step 108, the recording can still proceed. Furthermore, *Kuroda* never discloses that another storage device is (1) external to the recorder/player, (2) connected by a connection portion via the internet, (3) separately receives the program from the distribution center independently of the recording system and (4) separately receives the program by unidirectional communication as claimed in claim 8.

Lawler, et al. appears to disclose a system 10 has a central head end 12 that supplies programming over a network 14 to multiple viewer stations 16 that are typically located in the homes of system users or subscribers (column 3, lines 29-34). Network 14 carries bidirectional communication between the viewer stations 16 and the head end 12 (column 5, lines 28-31). A

user can set a record tag by activating a record button 130 (column 12, lines 29-31). The record tag can be thought of as a request to the system to record a program. Each record tag is associated with a program to be recorded and to view station or user that set the record tag (column 12, lines 56-61). When the record tag is set, it is stored at the head end 12 in servers 30 or 26 (column 13, lines 8-12). The head end monitors the record tags of all system users and if any user has set a record tag, the head end controls the recording device to record the program. The recorded program is stored at the head end 12 or servers 32 (column 13, lines 26-37).

Thus, *Lawler, et al.* merely discloses a network 14. Nothing in *Lawler, et al.* shows, teaches or suggests (a) a connection portion to connect with an external storage device, (b) the external storage device is external to the recording system (*i.e.* external to the receiving portion, request accepting portion, local storage portion, determination portion and issue portion), (c) the external storage device separately receives the program from the distribution center independent of the recording system as claimed in claim 8. *Lawler, et al.* clearly teaches that viewer stations receive programming over network 14 and thus never discloses the view stations and the head end separately and independently receive programming.

Finally, *Lawler, et al.* merely discloses a user setting the record tag which is stored at the head end 12. Nothing in *Lawler, et al.* shows, teaches or suggests an issue portion automatically issuing a recording substitution request to an external storage device in response to determination of a failure in the recording system as claimed in claim 8. Rather, in *Lawler, et al.*, the user sets the record tags.

A combination of *Kuroda* and *Lawler, et al.* would merely suggest to have a storage device 105 store signals and when insufficient capacity exists warn the user as taught by *Kuroda* and to have a user set record tags as taught by *Lawler, et al.* Thus, nothing in the combination of

the references shows, teaches or suggests (a) a connection portion connecting to an external storage device, external to the recording system, where the external storage device separately receives the program from the distribution center independently of the recording system and (b) an issue portion configured to automatically issue a recording substitution request to the external storage device in response to the determination of a failure in the recording system as claimed in claim 8. Therefore, Applicants respectfully request the Examiner withdraws the rejection to claim 8 under 35 U.S.C. § 103.

Claim 10 was rejected under 35 U.S.C. § 103 as being unpatentable over *Kuroda* in view of *Ellis, et al.* and further in view of *Zigmond, et al.* Claim 11 was rejected under 35 U.S.C. § 103 as being unpatentable over *Kuroda* in view of *Lawler, et al.* and *Ellis, et al.* and further in view of *Zigmond, et al.*

Applicants respectfully traverse the Examiner's rejection of the claims under 35 U.S.C. § 103. The claims have been reviewed in light of the Office Action, and for reasons which will be set forth below, Applicants respectfully request the Examiner withdraws the rejection to the claims and allows the claims to issue.

As discussed above, since nothing in the combination of the references shows, teaches or suggests the primary features as claimed in claims 1, 4 and 8-9, Applicants respectfully submit that the combination will not overcome the deficiencies of the independent claims. Therefore, Applicants respectfully request the Examiner withdraws the rejection to claims 10 and 11 under 35 U.S.C. § 103.

Thus, it now appears that the application is in condition for a reconsideration and allowance. Reconsideration and allowance at an early date are respectfully requested.

CONCLUSION

If for any reason the Examiner feels that the application is not now in condition for allowance, the Examiner is requested to contact, by telephone, the Applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed within the currently set shortened statutory period, Applicants respectfully petition for an appropriate extension of time. The fees for such extension of time may be charged to Deposit Account No. 50-0320.

In the event that any additional fees are due with this paper, please charge our Deposit Account No. 50-0320.

Respectfully submitted,

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